

**AMENDMENT**

Serial Number: 10/532,704

Filing Date: May 2, 2006

Title: Fluid-Assisted Electrosurgical Scissors and Methods

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Docket: TLK025

**REMARKS**

This Amendment is responsive to the Office Action mailed April 29, 2010, which has been carefully considered. At the time of the Office Action, claims 19-21 and 23-32 were pending, with claims 33-38 withdrawn from consideration. Thus, claims 19-32 were presented for examination.

The Office Action sets forth that Applicant's arguments provided in the prior response have been considered and found persuasive, however such arguments are now moot in view of new grounds of rejection.

With this Amendment, withdrawn claims 33-38 have been cancelled, without prejudice, claims 19-21 and 23-31 have been amended, and new claims 39-43 have been added to the application. Support for the amended and new claims is found in the originally filed application, particularly at locations identified hereinafter. Accordingly, Applicant believes no new matter has been added to the application.

Reconsideration and allowance of the subject application are respectfully requested for at least the following reasons.

**Claim Objections**

In the Office Action, claims 20-21 and 23-31 are objected to as incorrectly depending from cancelled claim 1.

Applicant has amended claims 20-21 and 23-31 to correctly depend from independent claim 19. Withdrawal of the objection is respectfully requested.

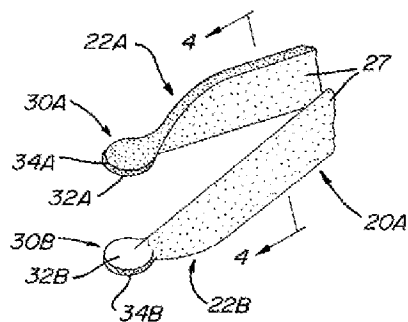
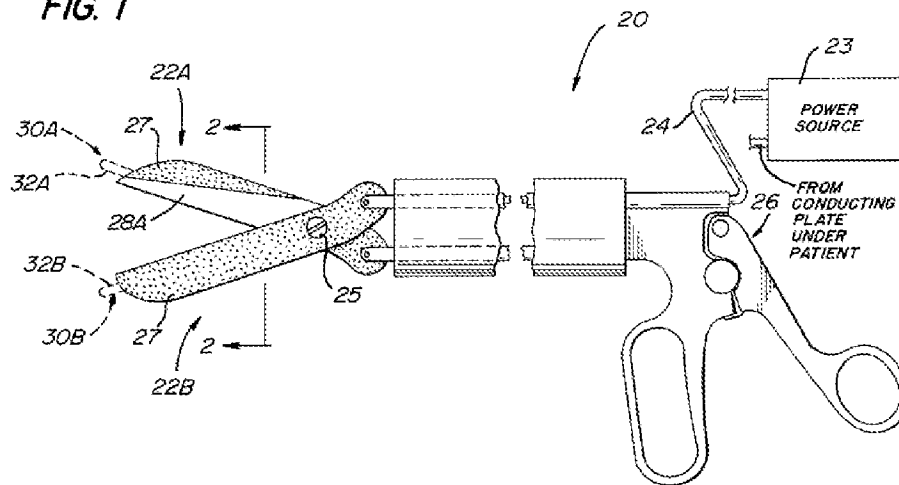
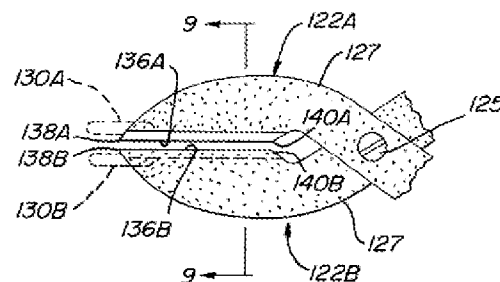
**35 U.S.C. §103 Rejections**

Claims 19-21, 23-29 and 31-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pennybacker et al., U.S. Patent No. 5,637,110 (hereinafter "Pennybacker") in view of Levin, U.S. Patent No. 5,827,281 (hereinafter "Levin").

Without acquiescing to the properness of the foregoing rejection, Applicant has elected to amend the claims to expedite prosecution and further distinguish from the art. Applicant will now address the cited art in relation to the amended claims.

Applicant has amended independent claim 19 to include the features of the first blade member comprising a first blade member shearing edge extending to a distal end of the first blade member, and the second blade member comprising a second blade member shearing edge extending to a distal end of the second blade member. Applicant has also amended independent claim 19 to include the features of the bulbous portion on an exterior side of the blade member proximally adjacent the distal end of the blade member. Support for the amendments may be found, for example, in the figures of the application, particularly figures 5 and 8-11, and in paragraph [0057] of the specification. Accordingly, Applicant believes no new matter has been added to the application.

Turning to the Office Action, and the cited art, the Applicant understands flattened tips 30A and 30B of Levin to be characterized by the Office as providing the feature of a bulbous portion protruding from a blade member as recited by independent claim 19. For convenience, Applicant has provided FIGS. 1, 3 and 8A of Levin below:

**FIG. 1****FIG. 3****FIG. 8A**

As may be understood from FIG. 8A (and similarly from FIGS. 1 and 3), cutting edges 136A, 136B, which appear to terminate distally at 138A, 138B, do not extend to a distal end of jaws 122A, 122B. As Applicant understands from Levin, tissue between the facing surfaces 32A, 32B distal to cutting edges 136A, 136B may be compressed and cauterized without cutting thereof to better inhibit bleeding. Col. 8, ll. 63-67. Thus, Applicant does not understand FIG. 8A (or FIGS. 1 and 3) to teach a first blade member comprising a first blade member shearing edge extending to a distal end of the first blade member, and a second blade member comprising a second blade member shearing edge extending to a distal end of the second blade member as recited by amended independent claim 19.

Furthermore, even if jaws having cutting edges extending to a distal end of the blade members could be shown in references other than Levin, Applicant does not believe such cutting edges may be combined with jaws 22A, 22B incorporate flattened tips 30A, 30B. Applicant believes that to modify the flattened tips 30A, 30B as shown in Levin in such a manner that a cutting edge would extend to a distal end of jaws 22A, 22B would arguably render the flattened tips 30A, 30B unsuitable for their intended purpose, which Applicant understands to be insufficient to render the present claims as *prima facie* obvious. As provided by MPEP §2143.01, [i]f a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Applicant believes it may be understood that Levin did not extend the cutting edges to the distal end of jaws 22A, 22B of FIG. 3 for this very reasoning.

Turning to the present invention, as Applicant's invention provides shearing edges that extends to a distal end of the blade members, a physician may be better enabled to cut tissue. For example, the flattened tips 130A, 130B of Levin would seem to impair a physician's vision of distal ends 138A, 138B of the cutting edges 136A, 136B as the scissors would be used to cut tissue. Thus, a physician may be placed in a somewhat risky position of cutting tissue at a distal end of the cutting edges without actually visually seeing the cutting as it is being performed. The Applicant's invention is not so limited.

As indicated, *infra*, Applicant has also amended independent claim 19 to include the features of the bulbous portion on an exterior side of the blade member proximally adjacent the distal end of the blade member. In contrast to Levin, Applicant understands the flattened tips 30A, 30B of Levin to be located at a distal end of jaws 22A, 22B rather than on an exterior side of the jaws 22A, 22B proximally adjacent the distal end of the jaws. Furthermore, Applicant understands that the flattened tips 30A, 30B to be located at a distal end of jaws 22A, 22B so that tissue to be compressed and cauterized with flattened tips 30A, 30B would be in alignment with the cutting edges of jaws 22A, 22B. However, because the present invention is not limited to treating tissue in the foregoing manner as Levin, the Applicant's invention is not so limited as Levin to positioning the bulbous portion at a distal end of the jaws. Rather, as may be shown by FIG. 8 of the present application, Applicant's invention is particularly shown with the bulbous portion on an exterior side of the blade member proximally adjacent a distal end of the blade member to better treat tissue in a manner as taught by the Applicant.

Accordingly, the Applicant believes that it has been demonstrated that the claims herein define over the teachings of the cited references. In view of the foregoing remarks, it is respectfully submitted that independent claim 19 is patentable over the art. Allowance of independent claim 19, as well as the pending claims which depend directly or ultimately therefrom, is respectfully requested.

Claim 30 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Pennybacker in view of Levin and further in view of Rydell, U.S. Patent No. 5,352,222 ("Rydell").

Claim 30 depends ultimately from independent claim 19. Applicant has amended claim 19, and believes the rejection of claim 30 to be rendered moot particularly as Rydell is not understood by the Applicant to provide the missing teachings of Pennybacker and Levin as outlined, *supra*, to maintain a rejection of the claims as being unpatentable under 35 U.S.C. §103(a). Reconsideration and allowance of claim 30 which depends directly from claim 19, is respectfully requested.

### **New Claims**

The Applicant has added new claims 39-43 to the application to further define the invention and/or distinguish from the cited art. Support for claims 39-43 may be found, for example, in the figures and paragraph [0054] of U.S. Publication No. 2006/0235379.

No claim fee is believed necessary as the number of new claims does not exceed the number of claims cancelled herein. However, in the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account 50-2121.

### **SUMMARY**

The Applicant respectfully submits that, in light of the foregoing remarks, and having dealt with all the rejections raised by the Examiner, the claims are in order for allowance. Thus, early allowance is earnestly solicited.

If the Examiner desires personal contact for further disposition of this case, the Examiner is invited to call the undersigned Attorney at 603.668.6560.

In the event there are any fees due, please charge them to our Deposit Account No. 50-2121.

Respectfully submitted,

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